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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,463	07/11/2001	Andrew P. Levy	01/22194	5455

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EXAMINER
SNEDDEN, SHERIDAN

ART UNIT	PAPER NUMBER
1653	5

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,463	LEVY, ANDREW P.	
	Examiner	Art Unit	
	Sheridan K Snedden	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-197 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-197 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to a method of evaluating a potential of a haptoglobin as an antioxidant, classified in class 424, subclass 9.1.

II. Claims 10-37, drawn to an antioxidant protein of SEQ ID NO: 19 or 20, classified in class 530, subclass 350.

III. Claims 38-65, drawn to an antioxidant protein of SEQ ID NO: 15 or 16, classified in class 530, subclass 350.

IV. Claims 66-89, drawn to a method of reducing oxidative stress with an antioxidant protein of SEQ ID NO: 19 or 20, classified in class 514, subclass 2.

V. Claims 90-113, drawn to a method of reducing oxidative stress with an antioxidant protein of SEQ ID NO: 15 or 16, classified in class 514, subclass 2.

VI. Claims 114-137, drawn to a nucleic acid construct comprising the sequences of SEQ ID NO: 13 and 14, classified in class 536, subclass 23.1.

VII. Claims 138-161, drawn to a nucleic acid construct comprising the sequences of SEQ ID NO: 9 and 10, classified in class 536, subclass 23.1.

VIII. Claims 162-179, drawn to a method of reducing oxidative stress by administration to a subject a nucleic acid of SEQ ID NO: 13 or 14, classified in class 514, subclass 44.

IX. Claims 183-197, drawn to a method of reducing oxidative stress by administration to a subject a nucleic acid of SEQ ID NO: 9 or 10, classified in class 514, subclass 44.

2. The inventions are distinct, each from the other because of the following reasons:

Invention I is related to Inventions II and III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of invention I may be used with materially different process, such as the products of Inventions II and III or other antioxidant proteins.

The methods of inventions I, IV, V, VIII and IX require different products and steps and have different endpoints. Therefore, inventions I, IV, V, VIII, and IX are patentably distinct.

The product of inventions VI and VII is not used in the method of invention I. Therefore, invention I is patentably distinct from invention VI and VII.

Each of inventions II, III, VI and VII are directed to patentably distinct and/or independent peptides, or nucleic acids encoding same. Absent factual statement/evidence to the contrary, each different peptide sequence and/or polynucleotides sequence encoding same is considered distinct and/or independent, one from the other on the basis of physical, chemical and biological properties and function(s).

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of invention II can be used in a materially different process such as generating antibodies, for example.

The product of invention II is not used in the method of invention V, VIII and IX. Therefore, invention II is patentably distinct from invention V, VIII and IX.

The product of invention III is not used in the method of invention IV, VIII and IX. Therefore, invention II is patentably distinct from invention IV, VIII and IX.

Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of invention III can be used in a materially different process such as generating antibodies, for example.

The products of inventions IV and V is not used in the method of invention VI and VII. Therefore, inventions IV and V are patentably distinct from invention VI and VII.

Invention VI is related to invention VIII as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, nucleic acid of invention VI may be used in a materially different process such as in a process for in vitro diagnostics.

The product of invention VI is not used in the method of invention IX. Therefore, invention VI is patentably distinct from invention IX.

Invention VII is related to invention IX as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, nucleic acid of invention IX may be used in a materially different process such as in a process for in vitro diagnostics.

The product of invention VII is not used in the method of invention VIII. Therefore, invention VI is patentably distinct from invention VIII.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IX, restriction for examination purposes as indicated is proper.

Advisory Information

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan K Snedden whose telephone number is (703) 305-4843. The examiner can normally be reached on Monday - Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3975 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SKS
July 2, 2003

SKS

Karen Cochrane Carlson PhD

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER